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Section II: REMARKS

It is respectfully requested that the changes as noted above in Section I be made to the present application.

In the above identified Office Action, the elected claims 1-25 and 33 were rejected. Applicant notes that non-elected claims 26-32 and 34 have been withdrawn from current consideration and applicant reserves the right to file a Divisional Application for consideration of the non-elected claims.

The Examiner's withdrawing of prior objections and rejections in view of applicant's previously filed amendment has been noted with appreciation.

In the Office Action mailed 12/10/2008, claims 1-12 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,456,938 to Barnard (herein referred to as "Barnard"), claims 13-25 were rejected under 35 USC 103(a) over Barnard in view of Irish et al (US Patent 6,691,032, herein referred to as "Irish"), and claim 21 was rejected "at least because it depends from a rejected claim".

The above-noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claim in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended several of the claims for clarification purposes only, to place all of the

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rejected claims in condition for allowance and/or in better condition for an appeal.

More specifically, it is noted that in the rejection of claim 1, the Examiner alleges that the "vertex" points of Barnard are equivalent to what the applicant claims as "geometric shapes". However, it is submitted that the vertex points of Barnard are just points and are not, and do not even suggest, areas. Barnard uses a series of the GPS vertex points to define boundary of a feature on a golf course. **The shape of the vertex points themselves do not represent an area but rather only a certain characteristic of the point such as the confidence level in the respective accuracy of the point** (Barnard, column 13, line 42 *et seq.*). Applicant selects a geometric shape to represent an approximation of a selected specific area and then provides means for adjusting the relative size of the selected geometric shape to fine-tune the fit whereas Barnard takes a plurality of GPS readings to define a feature on a golf course. In Barnard, there is not even a suggestion that the shape of each vertex point defines any area at all for any reason within the shaped graphic representation of a vertex point itself.

In order to even further clarify this distinction, the only independent claims 1 and 33 have herein been amended to recite "said method being effective for defining one or more differently shaped specific land areas of user-selectable predetermined geometric area configurations within a larger overall land area" (see applicant's Figure 4), and also "said desired geometric shape being used to establish a perimeter surrounding one of one of said specific land areas". The added clarifying language is submitted to clearly distinguish claims 1 and 33 from the Barnard

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reference. Barnard neither discloses nor suggests anything that would correspond to the predetermined geometric area configurations disclosed and claimed by the applicant.

Further, applicant has herein amended claim 2 to recite "enabling a user to input specific parameters with regard to said desired geometric shape, said specific parameters being used to establish a relative size of said desired geometric shape within said larger overall land area". There is nothing in the Barnard reference that would enable a user to input a parameter (such as, for example, the desired diameter of a circle) which would establish the relative size of the predetermined geometric shape within a larger overall land area. This sizing feature is not shown or even suggested by Barnard. Thus the allowance of claim 2 is evident either as a dependent claim from claim 1 and also if written as an independent claim separate from claim 1.

Thus, for at least the reasons stated above, it is believed that claims 1-12 are allowable under 35 USC 103(a) over Barnard.

Further, since Irish also does not disclose the predetermined geometric shape selection or the enablement of user-sizing of the selected shape as recited in the claim 1 methodology as herein amended, it is believed that claims 13-25, which ultimately depend from and include all of the limitations of claim 1 in addition to the even further limitations set out in the dependent claims themselves, are also allowable under 35 USC 103(a) over Barnard even in further view of Irish.

Still further, since claim 33 has herein been amended to contain the clarifications included in claims 1 and 2, it is submitted

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that claim 33 is also allowable under 35 USC 103(a) over Barnard.

With general reference to all of the 35 USC 103 rejections, it is noted that applicant is not claiming that any of the individual elements of the claims as herein presented is new *per se*.

Applicant is, however, claiming that the entire **combination of elements and relationships** among those elements as set out in the clear language of the claims as herein amended, is patentable. It is established that all inventions are, **and must be**, made up of known elements. However, the referencing of isolated elements in different contexts without any specific or stated suggestion of a beneficial combination or nexus cannot provide the basis to reject applicant's combination claims. Applicant is aware the individual elements of any claim can be isolated, and those elements, in different contexts, can be found in existing references. The similarity of various pieces and parts of the references as noted on pages 3-9 of the above-identified Office Action have been noted but it is believed that there is no suggestion or nexus in any of the references to even suggest any combination of those references or the total **combination of elements and relationships as recited in the claims as herein amended**.

Where there is no teaching or suggestion in any of the references for the specific total combination of elements and relationships among those elements, as claimed by an applicant, it is submitted to be inappropriate to search the prior art using applicant's own disclosure as a recipe, to find piecemeal elements in prior art references for individual claimed elements, and then to combine those references in a manner not disclosed or even suggested by any of the references in order to reject applicant's own claims.

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In that connection, it is even further noted that, not only is there no suggestion in the references for the hypothetical combination of references, but any combination of references would render the individual references inoperable for its stated intended purpose thus confirming the absence of any possible suggestion for the proposed combination. Since the substitution of pieces of one reference for other pieces of another reference would destroy each for its intended purpose, it is unsupportable and illogical to allege that a combination of the two references is obvious to one of ordinary skill in the art, or that the combination is suggested by any of the references.

Therefore, as herein amended, Claims 1-25 and 33 are submitted to be in condition for allowance an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for claim language changes for expediting the allowance of this application, and especially if one or more new references are cited, the Examiner is invited to contact the undersigned at the telephone number indicated below, prior to the issuance of another Office Action, in order to allow the applicant the opportunity to further amend the claims by Supplemental Amendment or Examiner's Amendment, as may be appropriate, to place the claims in condition for allowance. The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

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